

ESTTA Tracking number: **ESTTA723384**

Filing date: **01/28/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217589
Party	Plaintiff Rhythm Holding Limited
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Attachments	91217589 OPPOSITION TO MOTION TO COMPEL.pdf(3236691 bytes )

1 Applicant's first motion to compel (Paper No. 8) was filed on May 5, 2015, and was denied in an Order dated August 29, 2015 (Paper No. 14), the Board finding that "Applicant failed to make a sufficient good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention." Applicant then attempted to raise new issues while seeking reconsideration of that denial of its first motion to compel, but "without having made any effort to discuss these alleged deficiencies with Opposer." (Paper No. 25, page 4).

made a good faith effort to resolve the issues presented in the motion.<sup>2</sup> Applicant's counsel could not make such a statement because there was no good faith effort.

This time, Applicant's counsel sent a letter to Opposer's counsel on January 7, 2016, "outlining the remaining issues," and then ON THE VERY NEXT DAY, he filed the subject motion to compel. Plainly, Applicant has not made a good faith effort to resolve the remaining disputes and has not complied with the Rule.

Trademark Rule 2.120(e)(1) calls for the moving party to show that it has made a good faith effort to resolve the issues presented in the motion, and that the parties were unable to resolve their differences. Thus, more recently the Board clarified that "[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought." *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis supplied), quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988).

*Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

Rather than confer with Opposer in order to discuss and resolve the issues, Applicant rushed to file its motion, apparently in order to further delay the proceeding and postpone the testimony periods. Opposer Rhythm has repeatedly demonstrated its willingness to amicably resolve any discovery disputes, but Applicant's weapon of choice is not to discuss the matter and seek compromise, but to fire off a motion to compel in blatant disregard of the Trademark Rules.

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<sup>2</sup> Rule 2.102(e)(1) states, in pertinent part "A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences." (Emphasis supplied).

Opposer Rhythm requests not only that this premature motion to compel be denied, but that the Board sanction Applicant for its burdensome and dilatory tactics by refusing to accept any further discovery motions from Applicant.

II. Applicant's Refusal to Discuss the "Remaining Issues"

Opposer Rhythm has attempted to resolve what Applicant sees as disputed discovery issues by twice revising and supplementing its discovery responses. Rhythm did so in its SUPPLEMENT TO OPPOSER'S OPPOSITION TO APPLICANT'S REQUEST FOR RECONSIDERATION (Paper No. 24, filed on November 3, 2015). And it did so again on December 3, 2015. (That document, entitled OPPOSER'S RE-REVISED RESPONSES TO APPLICANT'S INTERROGATORIES, is attached as an Exhibit to the instant motion to compel). In fact, Applicant concedes that these amended and supplemental responses "resulted in significant progress." (Applicant's Motion to Compel, Paper No. 28, page 3).

After Opposer served its re-revised interrogatory answers on December 3, 2015, Applicant made no attempt to contact Opposer in order to discuss any discovery issues remaining, despite the fact that "significant progress" had previously been made. Only on January 7, 2016, did Applicant write its letter to Opposer, and then it filed the instant motion on the very next day.

Since Applicant's filing of the instant motion to compel, Opposer's counsel has made four e-mail requests for a telephone conference with Applicant's counsel, seeking to discuss whatever issues remain unresolved. Applicant's counsel has declined to make himself available for a telephone call.



This case was suspended as a result of Applicant's request for reconsideration (Paper No. 15) filed on September 28, 2015, and its Petition to the Director (See Paper No. 26)) relating to the Board's denial of Applicant's first premature motion to compel. Proceedings herein were resumed on January 2, 2016.

Discovery closed on January 8, 2016. As a result of Applicant's latest motion to compel, this case has been suspended for the fourth time due to Applicant's dilatory tactics.

### III. The Nature of This Proceeding

This is a simple trademark opposition proceeding, involving overlapping goods. Standing and priority are not in issue. There are no limitations on channels of trade or classes of consumers in the opposed application or the cited registrations. In other words, given the narrow scope of the contested issues, this proceeding should have progressed relatively smoothly and quickly.

Despite the straightforward nature of this case, however, Applicant has served sweeping discovery demands, calling for "all documents" relating to numerous issues well beyond the scope of this proceeding.<sup>3</sup> Opposer Rhythm has been attempting to provide reasonable responses to meet Applicant's discovery needs, but Applicant is never satisfied. Its tactic of filing motions to compel, rather than pursue reasonable and amicable resolution of the issues, has caused this case to languish and has time and again wasted the time and resources of the Board and of Opposer. The Board should put a stop to these tactics immediately.

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<sup>3</sup> At the same time, Applicant has refused to provide proper responses to a large number of Opposer's discovery requests, as will be detailed in Opposer's own Motion to Compel.

IV. The Board's Inaccurate Statement Regarding Opposer

In its Order of January 2, 2016 (Paper No. 27), the Board implies that Opposer has not been cooperative in producing documents, stating that because Opposer has commenced fifteen *inter partes* proceedings over the past six years, Opposer “should have information necessary to respond to interrogatories regarding its pleaded RHYTHM mark already prepared.”(See footnote 9 at page 7). Opposer respectfully points out, however, that nearly every one of those prior proceedings was terminated at an early date, and in only two proceedings did the other party seek discovery (in 2011 and 2012). Opposer has provided to the Applicant J& N Sales, the relevant documents that were collected in those two older cases. However, in neither of those cases did the other party make the sweeping discovery demands that Applicant J&N Sales has made here.

Thus for the Board to suggest that Opposer Rhythm should have at hand information that was never before requested in other proceedings is quite unfair. The record here shows that Opposer has attempted in good faith to provide Applicant with the discovery that Applicant is reasonably entitled to, including documents and information that Opposer had already compiled. But to suggest that Opposer should have at its fingertips every bit of information that Applicant J&N Sales demands, and that Opposer is deliberately holding back that information, is not only unfounded but untrue.

V. Some Comments on the “Remaining Issues”

Rather than waste more time responding in depth to Applicant's defective motion, Opposer Rhythm would simply like to highlight several points. By doing so, however, Rhythm does not concede that there are no other arguments or responses to the disputed

issues, nor does it waive its right to raise such arguments or responses to those disputed issues in the future.

Opposer Rhythm has properly and completely responded to Applicant's Interrogatories 1, 2, and 4, subject to Opposer's stated objections and to the extent that the interrogatories seek information relevant to this proceeding. Applicant J&N is now trying to expand the scope of these interrogatories beyond the selection and adoption of the RHYTHM mark (information that is in the possession of Opposer's predecessor), to encompass all documents relating to the purchase or assignment of the mark. Not only does that demand go beyond the scope of the original interrogatories, but it is inconceivable how documents generated more than five years ago can have any significance as to the strength of the RHYTHM mark today.

As to Interrogatory No. 7, Applicant has finally conceded that the original language of this interrogatory is incomprehensible, just as Opposer has been saying all along. Applicant now states, in its January 7, 2016 letter, that this interrogatory seeks the identification of documents that "directly discuss or define those target market criteria" (*i.e.*, demographics, consumer behavior, price points, etc.). In light of that clarification, Opposer Rhythm revised its Response to Interrogatory No. 7 in an email sent to Applicant's counsel on January 20, 2016, stating as follows:

Opposer objects to this request on the ground that it seeks documents that are not relevant to the subject matter of this proceeding and are not likely to lead to the discovery of admissible evidence. Neither the pleaded registrations nor the opposed application include any limitations as to classes of consumers or price points or other such demographic character[istics]. Furthermore, and without waiving the above-stated objection, Opposer states that it has no such documents.



As to Interrogatories 12, 14, 15 and 19, and document requests nos. 1, 3, 11, and 14, Applicant J&N fails to explain how correspondence with third parties has any relevance to the narrow issues in this case. For example, what possible relevance could there be in all correspondence regarding settlement negotiations? Once again, Applicant's sweeping discovery bears no relationship to the relevance of the information and documents that it demands.

The Board has pointed out more than once that the principle of "proportionality" should be applied when considering the bounds of discovery in an *inter partes* proceeding.

When it comes to serving discovery, the parties are expected to take into account the principles of proportionality with regard to discovery requests such that the volume of requests does not render them harassing and oppressive and are expected to consider the scope of the requests as well as to confer in good faith about the proper scope of discovery so as to minimize the need for motions.

*Joshua Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1266 (TTAB 2015).

Here, the scope of Applicant's discovery demands are plainly out of proportion to the issues in the case and to Applicant's need for discovery thereon.

#### VI. Conclusion

Applicant's motion to compel should be denied because it was filed in blatant violation of the express requirements of Trademark Rule 2.120(e)(1). This is the third time that Applicant has flouted that Rule, and therefore Opposer requests that the Board issue an Order preventing Applicant from filing any more discovery motions.



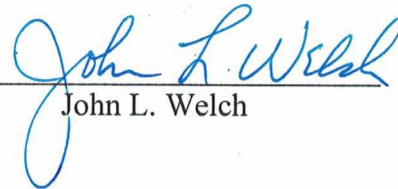
RHYTHM HOLDING LIMITED



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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served upon Applicant this 28th day of January, 2016, by mailing a copy thereof via first-class mail, postage pre-paid, to James A. Power, Jr., Esq., Power Del Valle LLP, 233 West 72<sup>nd</sup> Street, New York, NY 10023.

  
John L. Welch